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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,655	10/19/2000	Gary E. Smith	GSMITH.002A	7733

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EXAMINER

THISSELL, JENNIFER I

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/692,655

Applicant(s)

SMITH, GARY E.

Examiner

Jennifer I Thissell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-6,8-15 and 18-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-6,8-15, 18-25,27-36 is/are rejected.
- 7) ☒ Claim(s) 26 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 4-6, and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fifield ('940). Fifield teaches a support element 2 that is capable of being in between a roof tile or any other element and a roofing surface, it is capable of supporting any number of tiles, the support element is in the shape of a wedge, the support element is expanded polystyrene, and the support element has a large surface area and a cross-section that is quadrilateral. There is at least one groove (Figure 2) in the bottom surface of the element, the top and bottom surfaces are substantially planar and non-parallel to one another, and the rear surface height is less than the front surface height.

Fifield does not state dimensions of the element that are about four feet long, between seven and a half and eleven inches wide, and between one and two inches in height. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create the element with any dimensions including the dimension that are stated above,

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since discovering an optimum value or workable range involves only routine skill in the art. It is a matter of engineering design choice to select the size of an element, depending on the size and amount of elements that are to be supported on it, as well as the load that it should be able to carry.

Claims 8-15 and 18-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly ('950) in view of McCorsley et al. ('826) in view of Fifield ('940). Kelly teaches a roof system that has a roof surface D (roof deck), a plurality of wedge shaped quadrilateral cross-sectioned support elements (Figure 2B) in contact with the roofing surface, the support element is made of a lightweight material (polystyrene), and the support elements are configured to receive any suitable roofing material.

Kelly does not state a specific roofing material of tile to be placed on the support element, nor that at least four could be placed. McCorsley shows that roofing tiles, or shingles, are known to be placed on support elements 10 over roof decking surfaces, and Fifield shows that concrete roof tiles are known to be placed on support elements over roof decking surfaces. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to place any well-known roofing tile material, in numbers of at least four, such as concrete tiles or shingles on the support element, since it has been shown that these materials are extremely well known and often utilized in the roofing industry. Any number of roofing tiles or shingles could

be placed on Kelly's support elements since roofing tiles come in various sizes and Kelly's support element is of a length that would be able to support many roofing tiles.

Claims 23-25 and 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feil et al. ('102). Feil teaches support elements 28, roof tiles 25, and a roofing surface. The support element is placed on the roofing surface, a tile is placed on the support element, a central portion (at the front) of the tile is substantially supported by the support element, the tile is secured to the roofing surface by a nail 32, a second and third tile is placed on the support element (as seen in Figure 5), the roof tile is in contact with both the roofing surface and the support element, a second tile is in contact with the first tile, and the nail passes through a portion of the support element.

Feil does not teach the method steps of installing roof tile supports, however, since all of the structural elements have been disclosed above, the steps of placing and securing are considered obvious method steps to one having ordinary skill in the art at the time the invention was made. It is also clear that the support elements are placed first since they are ultimately located below the roof tiles.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ilnyckyj ('888). Ilnyckyj teaches a support element 60 and a roof tile above it,

as well as a second support element that is positioned to the side of the first support element, leaving a gap between the two elements. Ilnyckyj does not teach the method steps of placing the support element on the roofing surface and then the roof tile on the support element, since he teaches that the support is adhered to the underside of the tile and therefore the support and tile would be placed on the roof at the same time. However, it would have been obvious for one having ordinary skill in the art at the time the invention was made to place the elements separately, since constructing a formerly integral structure in various elements involves only routine skill in the art.

***Allowable Subject Matter***

Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Prior art fails to teach a method of installing roof tile supports in a manner described in claim 23, in addition to placing first roof tiles in a manner in which the first tile does not contact a roof tile in an adjacent lower course.

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I Thissell whose telephone

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number is (703) 306-5750. The examiner can normally be reached Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Friedman can be reached on (703) 308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



January 23, 2003



Carl D. Friedman  
Supervisory Patent Examiner  
Group 3600